



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/758,646	01/14/2004	Satoshi Otsuka	17364	6274

23389 7590 08/17/2005

SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

EXAMINER

JOHNSON III, HENRY M

ART UNIT	PAPER NUMBER
----------	--------------

3739

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/758,646

Applicant(s)

OTSUKA ET AL.

Examiner

Henry M. Johnson, III

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9 and 10 is/are rejected.
- 7) ☐ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 051304.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: on page 22, both the grasping portion and the sheath are given the label 30.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 7 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is indefinite as the L-shaped form is disclosed in the specification as being part of the endoscope insertion portion, while the claim cites it as part of the longitudinal grasping element.

Claim 7 cites a connecting member that is not clearly disclosed in the specification as to make its structural position clear. The only member that appears capable of allowing longitudinal movement of both the grasping member and the ball joint is the arm portion already claimed in the independent claim.

Claim 10 is indefinite as the center of gravity is variable, dependent on the size and weight of the medical instrument and the attitude of the grasping member.

Claim Rejections - 35 USC § 103

Art Unit: 3739

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-3, 7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,825,536 to Yasunaga et al. in view of Japanese Patent Application KOKAI Publication No. 2001-258903. Yasunaga et al. teach a device for positioning a surgical microscope that attached (is fixed) at one end and includes an articulated arrangement of arms to provide multiple degrees of freedom in the positioning of the instrument and includes counterweights (abstract). Electromagnetic brakes for portions of the arm are disclosed. Yasunaga et al. do not disclose a longitudinal element for holding an instrument. KOKAI Publication No. 2001-258903 discloses a holding device employing a counter balancing system with links and using a ball joint element at one moving portion arranged at a leading end of an arm. In this device, the leading end of the arm to be positioned in the proximity of an operating position is miniaturized by a ball joint element. A long medical instrument held in a holding element movable around the ball joint. The holding element is interpreted as having a longitudinal axis in the fore and aft direction (Fig. 13A of instant application), thereby having the

Art Unit: 3739

long instrument at a right angle to the axis and the ball joint is above the axis. In both disclosures, the portion holding the medical instrument is capable of being grasped.

Regarding claim 3, the rearrangement of parts of the ball joint is considered obvious to one having ordinary skill in the art at the time the invention was made to, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

Regarding claim 7, any member of the arm of Yasunaga et al. can be interpreted as a connecting member that clearly moves the instrument portion in any number of directions.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,825,536 to Yasunaga et al. in view of Japanese Patent Application KOKAI Publication No. 2001-258903 ('25903) as applied to claim 1 and 2 above, and further in view of U.S. Patent 5,857,492 to Salamun. Yasunaga et al. is discussed above as having electromagnetic braking elements, but not specifically for a ball joint. Salamun teaches an electromagnetic braking for a ball joint (abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the ball joint brake as taught by Salamun in the invention of Yasunaga et al. Japanese Patent Application KOKAI Publication No. 2001-258903 to lock the ball joint portion of the movable support apparatus.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,825,536 to Yasunaga et al. in view of Japanese Patent Application KOKAI Publication No. 2001-258903 as applied to claim 1 and 2 above, and further in view of U.S. Patent 5,857,492 to Salamun as applied to claim 4 and further in view of U.S. Patent 6,569,084 to Mizuno et al. Mizuno et al. discloses an endoscope hold using electromagnetic brakes controlled by a switch on the portion of the device that is movable to control the position of the endoscope and that hold the endoscope (Fig. 1). It would have been obvious to one having ordinary skill in the art at

Art Unit: 3739

the time the invention was made to place the brake switches on the "grasping" portion as taught by Mizuno et al. of the invention of Yasunaga et al./ '25903/ Salamun as it is clearly a logical and intuitive place for such switches.

Allowable Subject Matter

Claim 8 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Support devices for positioning of medical instruments are pervasive, many and varied using various combinations of articulating methodologies, brakes or locking means and counterweights. Combinations of the known elements in different arrangements and/or locations, is clearly obvious to those skilled in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Henry M. Johnson, III whose telephone number is (571) 272-4768. The examiner can normally be reached on Monday through Friday from 6:00 AM to 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Henry M. Johnson, III
Primary Examiner
Art Unit 3739